

REMARKS

Claims 1-12 have been examined on their merits.

Applicant herein cancels claims 4, 6, 10 and 12 without prejudice and/or disclaimer.

Applicant herein adds new claims 13-18. The new claims 13-18 are fully supported by the specification, and do not add any new matter. Entry and consideration of the new claims 13-18 is respectfully requested.

Claims 1-3, 5, 7-9, 11 and 13-18 are all the claims presently pending in the application.

1. Claims 1-9 and 11 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Krank *et al.* (U.S. Patent No. 6,002,755) in view of Smyth *et al.* (U.S. Patent No. 6,347,224). The rejection of claims 4 and 6 is now moot due to their cancellation. Applicant traverses the rejection of claims 1-3, 5, 7-9 and 11, and insofar as the rejection might apply to new claims 13-18, for at least the reasons discussed below.

The initial burden of establishing that a claimed invention is *prima facie* obvious rests on the USPTO. *In re Piasecki*, 745 F.2d 1468, 1472 (Fed. Cir. 1984). To make its *prima facie* case of obviousness, the USPTO must satisfy three requirements:

- a). The prior art relied upon, coupled with the knowledge generally available in the art at the time of the invention, must contain some suggestion or incentive that would have motivated to artisan to modify a reference or to combine references. *In re Fine*, 837 F.2d 1071, 1074 (Fed. Cir. 1988).
- b). The proposed modification of the prior art must have had a reasonable expectation of

success, and that determined from the vantage point of the artisan at the time the invention was made. *Amgen, Inc. v. Chugai Pharm. Co.*, 927 F.2d 1200, 1209 (Fed. Cir. 1991).

- c). The prior art reference or combination of references must teach or suggest all the limitations of the claims. *In re Vaeck*, 20 U.S.P.Q.2d 1438, 1442 (Fed. Cir. 1991); *In re Wilson*, 424 F.2d 1382, 1385 (CCPA 1970).

The motivation, suggestion or teaching may come explicitly from statements in the prior art, the knowledge of one of ordinary skill in the art, or, the nature of a problem to be solved. *In re Dembiczak*, 175 F.3d 994, 999 (Fed. Cir. 1999). Alternatively, the motivation may be implicit from the prior art as a whole, rather than expressly stated. *Id.* Regardless if the USPTO relies on an express or an implicit showing of motivation, the USPTO is obligated to provide particular findings related to its conclusion, and those findings must be clear and particular. *Id.* A broad conclusionary statement, standing alone without support, is not “evidence.” *Id.*; *see also, In re Zurko*, 258 F.3d 1379, 1386 (Fed. Cir. 2001).

In addition, a rejection cannot be predicated on the mere identification of individual components of claimed limitations. *In re Kotzab*, 217 F.3d 1365, 1371 (Fed. Cir. 2000). Rather, particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed. *Id.*

The combination of *Krank et al.* and *Smyth et al.* fails to teach or suggest the forwarding of current cost information to a bill server, which is then stored in a subscriber database, as

recited in claim 1. The Patent Office acknowledges that telecommunications exchanges are not known for handling calls and generating the call detail records that are sent to a billing system. *See* May 5, 2004 Non-Final Office Action, pg. 2. The Patent Office further acknowledges that Krank *et al.* fails to teach or suggest that the tariff server is an independent server that receives tariff requests from several exchanges in a network. *See* May 5, 2004 Non-Final Office Action, pg. 3. The Patent Office also acknowledges that the combination of Krank *et al.* and Smyth *et al.* fails to disclose the forwarding of cost information from the CDR generating function to a bill server, which is then stored in a subscriber database on a tariff server. Although claim 1 is not rejected over Cameron *et al.* (U.S. Patent No. 6,317,490), Cameron *et al.* do not disclose the current cost information for an on-going or to-be-completed call, and the forwarding and storage of that current cost information. Instead, Cameron *et al.* disclose forwarding cost information in the form of billing summaries for telephone calls that are *already completed*. *See, e.g.*, col. 3, lines, 23-31; lines 58-65; col. 4, lines 51-56; col. 5, lines 36-40; col. 6, lines 41-44 of Cameron *et al.* Unlike the present invention, there is no teaching or suggestion in Cameron *et al.* of providing cost information to the subscriber for to-be-completed telephone calls or on-going telephone calls. Instead, Cameron *et al.* rely on the length of the completed call in order to determine the cost information that is presented to the subscriber. *See, e.g.*, col. 5, lines 36-40 of Cameron *et al.* Thus, Applicant submits that the Patent Office cannot fulfill the “all limitations” prong of a *prima facie* case of obviousness, as required by *In re Vaeck*.

Since neither Krank *et al.* nor Smyth *et al.* disclose the forwarding of current cost information to a bill server, which is then stored in a subscriber database, Applicant submits that

one of skill in the art would not be motivated to combine the two references. *In re Dembiczak* and *In re Zurko* require the Examiner to provide particularized facts on the record as to why one of skill would be motivated to combine the two references. Without a motivation to combine, a rejection based on a *prima facie* case of obviousness is improper. *In re Rouffet*, 149 F.3d 1350, 1357 (Fed. Cir. 1998)). The level of skill in the art cannot be relied upon to provide the suggestion to combine references. *Al-Site Corp. v. VSI Int'l Inc.*, 174 F.3d 1308 (Fed. Cir. 1999). The Examiner must make specific factual findings with respect to the motivation to combine references. *In re Lee*, 277 F.3d 1338, 1342-44 (Fed. Cir. 2002). Although the Patent Office provides a motivation analysis with respect to charging control systems, both *Krank et al.* and *Smyth et al.* lack any teaching about the forwarding of current cost information to a bill server, which is then stored in a subscriber database. Figures 2 and 9 of *Smyth et al.* depict a charge control system (91) that is separate from the billing system (23), and there is no disclosure that current cost information is sent from a BSC (or MSC) to the billing system and then to the storage (95, 96) in the charge control system. *Krank et al.* is similarly deficient with respect to the transfer and storage of current cost information. Thus, Applicant submits that the Patent Office cannot fulfill the motivation prong of a *prima facie* case of obviousness, as required by *In re Dembiczak* and *In re Zurko*.

Based on the foregoing reasons, Applicant submits that the combination of *Krank et al.* and *Smyth et al.* fails to disclose all of the claimed elements as arranged in claim 1. Therefore, the combination of *Krank et al.* not *Smyth et al.* clearly cannot render the present invention obvious as recited in claim 1. Thus, Applicant submits that claim 1 is allowable, and further

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submits that claims 2, 3, 13 and 14 are allowable as well, at least by virtue of their dependency from claim 1. Applicant respectfully requests that the Examiner withdraw the § 103(a) rejection of claims 1-3.

With respect to claim 5, Applicant submits that claim 5 is allowable for at least the same reasons discussed above with respect to claim 1, in that the combination of Krank *et al.* and Smyth *et al.* fails to teach or suggest the forwarding and storage of current cost information. Thus, Applicant submits that claim 5 is allowable, and further submits that claim 11 and 15-17 are allowable as well, at least by virtue of their dependency from claim 5. Applicant respectfully requests that the Examiner withdraw the § 103(a) rejection of claims 5 and 11.

With respect to claim 7, Applicant submits that claim 7 is allowable for at least the same reasons discussed above with respect to claim 1, in that the combination of Krank *et al.* and Smyth *et al.* fails to teach or suggest the forwarding and storage of current cost information. Thus, Applicant submits that claim 7 is allowable, and further submits that claim 8, 9 and 18 are allowable as well, at least by virtue of their dependency from claim 7. Applicant respectfully requests that the Examiner withdraw the § 103(a) rejection of claims 7-9.

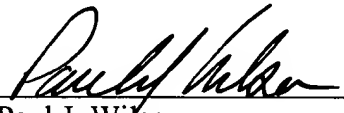
2. Claims 10 and 12 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Krank *et al.* in view of Smyth *et al.*, and in further view of Cameron *et al.* (U.S. Patent No. 6,317,490). The rejection of claims 10 and 12 is now moot due to their cancellation.

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In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

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